



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE:

Serial no.: 09/944,932
Filing date: 08/31/2001
For: Euphorbia plant named 'Charam'
Inventor: Tickner
Atty. Docket no.: PH39
Group Art Unit: 1661
Examiner: Para

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

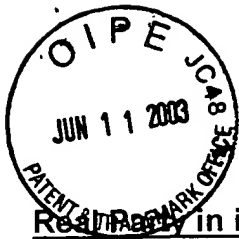
This is in response to the Notice of Appeal filed May 21, 2003.

Enclosed are triplicate copies of the appeal brief as required.

Respectfully submitted,

Mark P. Bourgeois
Reg. No. 37,782

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APPEAL BRIEF

Real Party in interest

The real party in interest in the present appeal brief is Notcutts Limited.

Related Appeals and Interferences

There are no related appeals or interferences.

Status of Claims

Claim 1 is pending. Claim 1 was finally rejected under 35 U.S.C. 102b as being unpatentable over United Kingdom Plant Breeders Rights Grant number 03000204 in view of public sales in the United Kingdom. The final rejection of claim 1 is being appealed.

Status of Amendments

There are no amendments that have not been entered.

Summary of Invention

The invention is a Euphorbia plant named 'Charam'. The invention is exemplified in claim 1, which recites a new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

Support for this is found in the specification on pages 1-7 and is shown in drawing sheets 1-3.

Issues

Issue 1 - Whether claim 1 is patentable under 35 USC 102 in view of United Kingdom Plant Breeders Rights Grant number 03000204 and being on sale in the United Kingdom.

Grouping of Claims

For each ground of rejection, which appellant contests herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

Argument

Issue 1 - Whether claim 1 is patentable under 35 USC 102 over United Kingdom Plant Breeders Rights Grant number 03000204 in view of sales in the United Kingdom.

Independent claim 1 recites a new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

The Examiner has noted that the variety that is the subject of this application has previously been protected by a plant breeder's rights certificate in one or more foreign countries. The Examiner further notes that the referenced plant breeder's rights certificate was published more than one year prior to the filing date of this plant patent application in the United States. The Examiner has used 37 CFR 1.105 to request information from the Applicant regarding whether the variety was publicly available anywhere in the world prior to the filing date of the present application. The Examiner cites *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (BPAI 1992) as authority for this request for information.

The public use and availability of the subject plant variety outside of the United States is not material to a determination of "plant patentability" of a plant variety in the United States under 102b.

The examination strategy set forth by the Examiner results in a denial of plant patent protection in the United States based upon prior art which does not make the plant variety available or accessible to the American public. It is the Applicant's belief that the Federal Circuit will not support any rejection based on such an examination policy.

The Examiner cites *Ex parte Thomson*, 24 USPQ 2d 1618, 1620 (BPAI 1992) to support the contention that a printed publication describing a new asexually reproducible plant variety, combined with the availability of the variety anywhere in the world, is sufficient to bar "plant patentability" of the variety under 35 U.S.C. 102(b).

The *Ex Parte Thomson* board admits that the printed publications cited were not, in and of themselves, enabling, and attempts to make those references enabling by combining them with the public availability of the cotton seeds in Australia. A non-enabling printed publication by itself cannot be cited as prior art under 102(b). Foreign public use alone cannot be cited as prior art under 102(b). *Ex Parte Thomson* combined these two non-prior art references.

It is improper to rely on a combination of references to anticipate the claimed invention under 35 U.S.C. 102(b). *Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.2d 724, 726 (Fed. Cir. 1984). Anticipation must be found in a single reference.

It is proper to cite an additional reference in making a rejection under 35 U.S.C. 102(b) only to show that the claimed subject matter, every material element of which is disclosed in the primary reference, was in possession of the public. See *Application of Samour*, 571 F.2d 559, 565 (CCPA 1978).

Ex Parte Thomson represents an improper use of 102(b) to deny utility patent protection for a plant variety based upon prior art references.

35 U.S.C. 102(b) reads, in pertinent part:

A person shall be entitled to a patent unless
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States . . .

If an invention has been in widespread public use in France for the last 30 years, but is not the subject of any printed publication, then the inventor has every right to file for and obtain patent protection in the United States. Section 102(b) allows such a result. The foreign use of the invention is not deemed to have made the invention available to the American public. It is immaterial to any 102(b) analysis that the French public may have had the invention for the last 30 years.

In order for the American public to access, use and duplicate a plant variety, propagatable plant material from the plant in question must be available in the United States. Without access to the plant material, the plant cannot be reproduced.

Foreign asexually propagatable plant material is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States. The quarantine act imposes rigorous importation requirements.

The court in *In re LeGrice* established a workable and rational approach for applying the policy and the language of 102(b) to this situation. The *In re LeGrice* case was concerned with whether or not foreign plant varieties are actually available to the American public. In the future, a printed publication might enable a person to make a

genetic duplicate or clone, of a particular plant without access to the plant itself. This is not possible at the present time. The *LeGrice* decision disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Under 35 U.S.C. 102(b), an invention is not patentable if it was described in a printed publication, in this or a foreign country, more than a year prior to the filing date of the U.S. application. In order for a printed publication to serve as a reference under 35 U.S.C. 102(b), it must enable the invention. *In re Donohue*, 766 F.2d 531, 533 (Fed. Cir. 1985). A written description of a plant variety is not enabling. Plant patents have always been exempt from the Section 112 written enablement requirement, which applies to all utility patents. A particular plant cannot be reproduced by reference only to a printed publication alone. Congress acknowledged this concept when the Plant Patent Act was drafted.

A non-enabling publication fails as a reference under 102(b). Foreign public or commercial activity fails as a barring activity under 102(b). Combining these two "non-references" to make a rejection under 102(b) is not proper.

The narrow scope of protection offered by a plant patent has a direct bearing on the scope of prior art that can be properly considered in determining the patentability of a new plant variety. Because a plant patent cannot be infringed without access to the new plant or its asexual progeny, a new plant variety cannot be anticipated without direct access in the United States to the new plant.

For a plant patent, propagatable material of the new variety is not only essential to enable the invention. It is the invention. In the absence of propagatable material, the variety does not exist, nor can it be made from the description in any printed publication,

regardless of how detailed or specific. Without any publicly available asexually propagatable plant material in the United States, no plant variety can, at the present level of technology, be anticipated by a printed publication, regardless of how detailed it is, and regardless of where it is published. The holding of *In Re LeGrice* is therefore controlling in the present case.


For the foregoing reasons, the cited Plant Breeder's Rights Certificate and sales in the United Kingdom are not a bar to patentability of the claimed new variety under 35 U.S.C. 102(b), because propagatable material of the variety is not available in the United States.

Conclusion

It has long been the practice of the U.S. Patent & Trademark Office to disregard the existence of foreign Plant Breeder's Rights certificates in determining patentability of a new plant variety. The USPTO has previously not considered foreign publication, use, or sale of a new plant variety to be a bar to patentability in the United States.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,

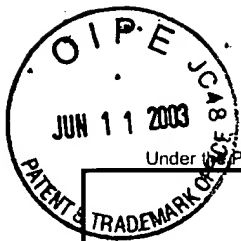


Mark P. Bourgeois
Reg. No. 37,782

Appendix

The claims involved in the appeal follow below:

1. A new and distinct variety of Euphorbia plant named 'Charam' as described and illustrated.

**Certificate of Mailing under 37 CFR 1.8****RECEIVED**
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FEE TRANSMITTAL for FY 2003

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)
320.00

Complete if Known

Application Number	09/944,932
Filing Date	08/31/2001
First Named Inventor	Tickner
Examiner Name	Para
Art Unit	1661
Attorney Docket No.	PH39

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METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit
Account
Number
Deposit
Account
Name

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 740	2001 370	Utility filing fee	
1002 330	2002 165	Design filing fee	
1003 510	2003 255	Plant filing fee	
1004 740	2004 370	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)
0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	=
Independent Claims	-3** =	X	=
Multiple Dependent			=

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 84	2201 42	Independent claims in excess of 3
1203 280	2203 140	Multiple dependent claim, if not paid
1204 84	2204 42	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)
0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 400	2252 200	Extension for reply within second month	
1253 920	2253 460	Extension for reply within third month	
1254 1,440	2254 720	Extension for reply within fourth month	
1255 1,960	2255 980	Extension for reply within fifth month	
1401 320	2401 160	Notice of Appeal	
1402 320	2402 160	Filing a brief in support of an appeal	320.00
1403 280	2403 140	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,280	2453 640	Petition to revive - unintentional	
1501 1,280	2501 640	Utility issue fee (or reissue)	
1502 460	2502 230	Design issue fee	
1503 620	2503 310	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 740	2809 370	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 740	2810 370	For each additional invention to be examined (37 CFR 1.129(b))	
1801 740	2801 370	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)
320.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type)	Mark P. Bourgeois	Registration No. (Attorney/Agent)	37,782	Telephone	574-522-7996
Signature		Date			

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